

The Examiner has restricted the invention under 35 U.S.C. §121 into the following groups:

- I. Claims 1-5 and 7, drawn to beta-lactam derivatives, classified in class 540, subclass 360.
- II. Claims 8-23, drawn to taxane derivatives and method of making the same, classified in class 549, subclass 510.

Applicants provisionally elect to prosecute Group I, claims 1-5 and 7, with traverse with respect to Group II.

The Examiner has stated that the inventions of Groups I and II are distinct from one another because of "their recognized divergent subject matter and different classifications based on their different chemical structures and the manufacturing." The Examiner continues to state that the search of one group would not be required for the search of the other group and that absent secondary teachings, one group could not be found obvious in view of the other.

According to MPEP §803, a restriction is proper only if the claims are able to support separate patents and they are either independent or distinct (806.05-806.05(g)). However, section 803 also states that even if distinct or independent claims exist, examination on the merits is required providing the search can be made without serious burden.

The claims of Group II of the present invention include methods of preparing taxane compounds which include the use of the compounds claimed in Group I. It is apparent from a thorough reading of the specification and the claims, that the compositions of Group I and the process of using the composition of Group II are sufficiently related to be considered together. Moreover, references, which disclose the use of the composition of Group II, would clearly be cited as prior art against those composition claims in Group I. The Examiner would certainly

feel obligated to consider such disclosure relevant and would not hesitate to cite references relating to one group against another under 35 U.S.C. §103. Thus, the Examiner would search the classes of Groups II to find a suitable reference to the composition disclosed in Group I and vice versa. For those reasons, Applicants maintain that a co-extensive field of search seems virtually mandated and would not present an undue burden.

In addition, the mere fact of separate classifications is not determinative of a proper restriction. Separate classification is merely a Patent Office convenience for the purpose of locating pertinent art. It is clear, therefore, that although diversity of classification may be the considered factor in a decision to make a restriction requirement, it should not be a controlling one. The Examiner may not properly rely on separate classifications to support an allegation of separate status in the art. The Examiner has also not made any further allegations as to why this restriction is proper.

For the reasons set forth above, Applicants respectfully request that the requirement for restriction be modified and consideration of all the claims in Groups I and II be commenced.

Should the Examiner have any questions, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number set forth below.

Respectfully submitted,



Jamie M. Larman  
Registration No. 48,623  
Attorney for Applicant(s)  
(973) 331-1700

BRISTOL-MYERS SQUIBB COMPANY  
P.O. Box 4000  
Princeton, NJ 08543-4000